



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,822	08/17/2000	Heinrich Gers-Barlag	Bei 637- KGB	6834

7590

08/07/2003

Norris McLaughlin & Marcus PA
220 East 42nd Street
30th Floor
New York, PA 10017

EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/07/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/640,822

Applicant(s)

GERS-BARIAG ET AL.

Examin r

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 25.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1617

DETAILED ACTION

Claims 16-30 are pending. The Arguments filed 11/15/02, Paper No. 20, in the After Final Amendment were responded to in the Advisory Action mailed 12/6/02, Paper No. 21, and the Final Rejection mailed 10/15/02, Paper No. 19.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/13/03 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16, 19 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 19 and 23 of copending Application No. 09/641013. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Art Unit: 1617

The instant claims are directed toward cosmetic or dermatological stick preparations, in the form of a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above 40 C, a water phase, modified phyllosilicate which has amphiphilic character and at most 0.5% of one or more emulsifiers. Boron nitride is taught as an additional pigment that can be added to the composition.

'013 teaches cosmetic or dermatological stick preparations, in the form of a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above 40 C, a water phase, boron nitride which has amphiphilic character and at most 0.5% of one or more emulsifiers. The preparations can further comprise auxiliaries, additives and/or active ingredients. Modified phyllosilicate pigments are taught as additional pigments in the composition. The reference lacks an exemplification of the preparation comprising modified phyllosilicates.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of '013 to exemplify a cosmetic or dermatological stick preparations, in the form of a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above 40 C, a water phase, boron nitride which has amphiphilic character, modified phyllosilicate pigments, and at most 0.5% of one or more emulsifiers because '013 teach modified phyllosilicate pigments as additional pigments that can be added to their preparations and because of the expectation of achieving increased stability, as the modified phyllosilicate pigments impart surfactant like properties to the preparations.

Art Unit: 1617

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 16, 19, 23-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11, 13, 18-21 of U.S. Patent No. 6,592,883 in view of Fanger et al. (6,153,204).

The instant claims are directed toward cosmetic or dermatological stick preparations, in the form of a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above 40 C, a water phase, modified phyllosilicate which has amphiphilic character and at most 0.5% of one or more emulsifiers. Boron nitride is taught as an additional pigment that can be added to the composition.

'883 teach a cosmetic or dermatological preparation, which is a finely dispersed water-in-oil system, comprising an oil phase, a water phase, a combination of modified phyllosilicate and boron nitride, wherein both phyllosilicate and boron nitride have amphiphilic character, at most 0.5% of one or more emulsifiers, and optionally one or more cosmetic or pharmaceutical auxiliaries, additives, and/or active substances. The reference lacks stick forms and a teaching of the oil phase components as melting above 40 C.

Fanger et al. teach water-in-oil emulsions comprising boron nitride, and being emulsifier free as being in the form of sticks. Oils and waxes melting above 40 C are taught as preferred oils for use in the oil phase of the emulsion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the composition of '883 in the form of a stick, as taught by Fanger, because of the expectation of achieving a cosmetically acceptable form of the preparation for

Art Unit: 1617

applying the composition smoothly and evenly on the skin. It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the oil phase of '883 as comprising oil and waxes above 40 C, as taught by Fanger et al. because of the expectation of achieving a water-in-oil preparation with cosmetically acceptable ingredients that do not easily melt in normal environments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. (6,153,204) in view of Msika et al. (5,939,054).

The instant invention is directed toward a cosmetic or dermatological stick preparation, which is a water-in-oil emulsion, comprising an oil phase which comprises 10-70% of fatty and/or wax components which melt above a temperature of 40 C, a water phase, at least one modified phyllosilicate pigment particles which exhibits both hydrophilic and lipophilic properties, at most 0.5% of one or more emulsifiers.

Fanger et al. teach cosmetic or pharmaceutical preparations with a reduced feeling of stickiness. The preparations are taught as emulsifier-free, water-in-oil lipodispersions. Lipsticks and deodorant sticks are taught as forms of the preparations, wherein the preparations are applied to the skin. Aluminum silicates, such as bentonites are taught as thickeners for use in the preparations. Paraffin oils, castor oil, isopropyl myristate, vaseline, lanolin, beeswax, ceresin,

Art Unit: 1617

ozokerite, carnauba wax, candelilla wax and others are taught as preferred oily substances (fatty and/or wax components which melt above 40 C). UVA and UVB filters, iron oxides, zinc oxides, antioxidants, dyes, coloring pigments and bactericides are taught as additional additives for use in the preparations (additives/active ingredients, amphiphilic metal oxides). Water-in-oil emulsions are preferred forms of the composition. The reference lacks preferred modified hectorites and methods of preparing the emulsions. See Col. 2, lines 6-34; Col. 3, lines 9-61; Col. 6, lines 54-62; Col. 8, lines 1-19; Col. 9, line 16-Col. 10, line 29.

Msika et al. teach water-in-oil sunscreen emulsions in the form of sticks. Quaternium 14 and 18 hectorite are taught as gelling derivatives for use in the emulsions. These compounds are further taught as optimizing the stability of water-in-oil emulsions and potentiating the solar protection in the highest protection factors. Taught is a method of making the emulsion, wherein the aqueous phase is added to the fatty phase with slow stirring.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant water-in-oil emulsions using the teachings of Fanger et al. because Fanger et al. teach emulsifier-free, water-in-oil emulsions comprising oily phase constituents that melt above 40 C and teach aluminum silicate (a phyllosilicate) as a thickener for use in the emulsion, wherein the emulsion can be in the form of a lipstick; hence, using the teachings of Fanger et al. to arrive at the instant invention would be within the skill of one in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the quaternium-18 hectorite of Msika et al. for the aluminum silicate in Fanger et al. because of the expectation of optimizing the stability of water-in-oil emulsions and

Art Unit: 1617

of potentiating the solar protection of the emulsion, and because the replacement of one phyllosilicate gelling agent for the other, for cosmetic thickening purposes, would be within the skill of one in the art.

Regarding the term "lipodispersion" in Fanger et al., it is respectfully pointed out that water-in-oil emulsions are lipodispersions, as the definition of an emulsion, as given by Webster's Collegiate Dictionary, is a liquid dispersed with or without emulsifier in an immiscible liquid.

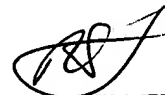
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
July 1, 2003


RUSSELL TRAVERS
PRIMARY EXAMINER